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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,824	12/26/2001	Simon Charles Martin	A34018PCT USA	9883

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NEW YORK, NY 10112

EXAMINER

FARAH, AHMED M

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/762,824

Applicant(s)

MARTIN, SIMON CHARLES

Examiner

Ahmed M Farah

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 21-41, 43 and 45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20, 42 and 44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/16/01; 6/22/04</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 21-39, 41, 43, and 45 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on June 14, 2004.

### ***Specification***

The disclosure is objected to because of the following informalities: in page 4, line 25 of the specification, the word "patent" is believed to be a misspelled word. Correction, such as --patient-- is required.

### ***Claim Objections***

Claim 3 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 2. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Applicant is advised that should claim 2 be found allowable, claim 3 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-7, 10, 14-18, 20, 42 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Koetting U.S. Patent no. 3,025,755.

Koetting discloses a fixation device for examining the visual field of patient's eye, the device comprising a fixation target means for locating in the field of view of the eye, said fixation target means including at least two elongate components having a fixed orientation as presently claimed (see Fig.1 and col. 2, lines 39-64).

As to claim 10, the device includes a central reference target, which flashes on and off in order to attempt to keep the subjects eye focused thereon, and an array of lights around it.

As to the method claims, the body of the claim following the preamble is a self-contained structure/process and does not depend on the preamble for completeness. A preamble that recites the use or purpose of the claimed invention generally does not limit the claim (*Catalina*, 62 USPQ2d at 1785).

Hence, the applicant's preamble does not limit the claims to a method for "alignment of an instrument with the axis of astigmatism" as recited. Therefore, the device of Koetting would provide the recited method steps as presently claimed.

Claims 1-3, 5-7, 14-18, 42 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Jolson U.S. Patent no. 5,094,521.

Jolson discloses a light fixation apparatus for limiting the rotation of the ocular globe of the eye as presently claimed, the apparatus comprising at least two intersecting fixation targets, wherein said at least two intersecting targets are substantially perpendicular to each other (see Fig. 3; 56-66; and Claim 13).

As to the method claims, since the preamble does not limit the claims as described above, Jolson would provide the recited method steps.

Claims 1-3, 5-9, 14-19, 42 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Abe et al. U.S. Patent no. 4,993,825.

Abe et al. disclose a fixation apparatus and methods of use, the apparatus comprising: at least two elongated, substantially perpendicular, fixation targets located in the field of view of the eye so that a patient may fixate on them (see Figs. 1 and 3; and col. 2, lines 26-51).

As to claims 8, 9, and 19, the fixation targets comprise a plurality of light emitting diodes (LEDs), the LEDs mounted on a printed circuit board.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abe et al.

Abe et al., described above, do not teach that one elongate fixation target is longer than the other. However, the applicant's written description (see page 8, lines 26-27) teaches that the shape and/or pattern of the elongate targets are not critical to the invention. Therefore, it would have been obvious to one skilled in the art at the time of the applicant's invention to modify the shape of the elongate targets and use fixation targets in which at least one component is longer than the other as presently claimed.

Claims 11, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimmick et al. U.S. Patent No. 5,549,597 in view of Abe et al.

Shimmick et al. disclose a laser surgical apparatus and methods of use for determining the astigmatism axis of a patient's eye and for treating the visual defects of the eye, the apparatus comprising a fixation means, ophthalmic microscope, and a laser source. However, they do not teach a fixation means comprising at least one elongate target as presently claimed.

Abe et al., described above, teach a fixation apparatus comprising at least one elongate target as claimed. Therefore, it would have been obvious to one skilled in the art at the time of the applicant's invention to modify Shimmick et al in view of Abe et al. and use a fixation target comprising at least one elongate target as an equivalent alternative eye fixation means.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the following references:

U.S. Patent No 4,870,964 to Bailey Jr. et al. discloses an ophthalmic surgical apparatus comprising a fixation target (see Figs. 5A-5C), operator feedback system, and a surgical laser.

U.S. Patent No. 5,841,511 to D'Souza et al. discloses an ophthalmic apparatus for measuring the corneal curvature of a patient's eye with astigmatism, the apparatus comprising an eye fixation system for aligning the optical axis of the apparatus with axis of the astigmatism of the eye.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ahmed M Farah whose telephone number is (703) 305-5787. The examiner can normally be reached on Mon-Thur. 9:30 AM-7:30 PM, and 9:30 AM - 6:30 PM on every other Friday.

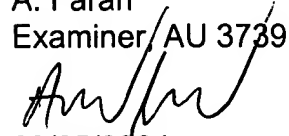
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M DVorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. Farah  
Examiner/AU 3739



09/05/2004